

REMARKS

The Amendments

Claim 1 is amended to incorporate the clarified recitations of claims 2 and 7-9 therein. Claim 1 and the other claims have also been reworded for clarity purposes and to address the 35 U.S.C. § 112 and § 101 rejections. Claims 10 and 11 are replaced with new claims 13 and 14. Claim 14 is previous claim 11 written in independent form. Support for the clarification of claims 7-9 and their corresponding part incorporated into claim 1 regarding the “residues” is inherent in the specification, e.g., from the structures obtained by the examples such as shown in the table at the bottom of page 8. Support for new claim 12 is found in the specification at page 3, lines 33-34.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101

The rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101 are believed to be rendered moot by the above amendments. But the following discussion is provided for clarity on two of the points.

The “easily” term is removed in connection with “easily degradable.” The removal of this term of degree is believed to eliminate any possible confusion or indefiniteness. The

claims define the “degradable” term by the manner of degradation, i.e., “by alkaline or enzymatic hydrolysis or by oxidative cleavage.” Given such recitation, it is believed that the meaning of this recitation would be sufficiently clear to one of ordinary skill in the art for 35 U.S.C. § 112 purposes.

Regarding the recitation of CORE (A) as “a biodegradable core selected from the group consisting of residues of pentaerythritol tetramercaptopropionate, trimethylolpropane trimercaptoacetate, and ethylene glycol dimercaptoacetate with the mercaptopropionate or mercaptoacetate groups removed,” it is believed this meaning would have been clear to one of ordinary skill in the art from the nature of the formula (i.e., the core must have bonding sites for the degradable bonded polycarboxylic chains) and from the disclosure (e.g., the examples, particularly the resulting structures shown therein).

The Rejection under 35 U.S.C. § 103

The rejection of claims 1-6 and 10-11 under 35 U.S.C. § 102, as being anticipated by Swift (“Water-Soluble Polymers” article) is respectfully traversed.

Initially, it is noted that claims 7-9 were not subject to this rejection and that the subject matter of claims 7-9 is now incorporated into the independent claims. Thus, it is believed that the rejection is rendered moot. But the following comments are provided for completeness.

In addition to the distinctions in the Core (A) from claims 7-9, now in the independent claims, it is submitted that general structure of the polymers discussed by Swift are additionally distinct from the claimed invention. Swift discloses that the BASF polymers prepared using the materials recited in Table 5 are “network polymers” having the general structure shown in Figure 3 on the same page. These network polymer structures do not have

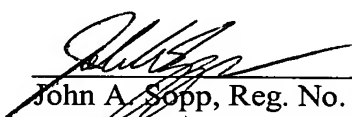
a central core from which all the carboxylic chains emanate. In Swift, the polycarboxylic chains have multiple attachments to crosslinkers which crosslink to other polycarboxylic chains. Swift provides no disclosure of hydrophilic degradable polymer which has multiple polycarboxylic chains bonded by degradable bonds to a single core. Also, regarding new claim 14 Swift discloses no hydrophilic degradable polymer which has multiple polycarboxylic chains bonded by degradable bonds to a single core wherein the polycarboxylic chains are additionally crosslinked. Although Swift discloses the crosslinking, there is no central core structure.

For the above reasons, it is urged that Swift does not anticipate any of the instant claims and, therefore, the rejection under 35 U.S.C. § 102 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John A. Sopp, Reg. No. 33,103
Attorney for Applicants

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: ATOCM-249

Date: April 21, 2004